

DENNIS P. CURRAN ET. AL.
Serial No.: 10/663,605

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REMARKS

Claims 19-21 have been canceled without prejudice or disclaimer. Claim 22 has been amended. Claims 22-23 remain before the Examiner for reconsideration.

In the Office Action dated June 15, 2004, the Examiner rejected claims 19-22 under 35 U.S.C. 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Specifically, the Examiner asserted that:

a. Claim 19,

- Definition of R4, what are the groups hanging on 'nitrogen'? A definition is not found in the specification.
- The groups added in the last two lines in the definition of R4 should be placed under the definition for R3.

b. Claim 21, R3 as 'nitrogen, -CH₂C1 or a 4-methylpyrazinomethyl group' has no antecedent basis in the base claim 19. What are the groups hanging on 'nitrogen'? A definition is not found in the specification.

c. Claim 22, definition of R10, what is 'Uor'?

Claims 19-21 have been canceled, thereby obviating the Examiner's rejection of those claims. Applicants have amended claim 22 to obviate the Examiner's rejection under section 112. Applicants respectfully assert that claim 22 as amended fully complies with the requirement of Section 112. Moreover, the amendment to claim 22 is solely to correct an inherently obvious typographical error (that is, deleting "Uor" and inserting therefor "or") and does not effect the scope of claim 22 or any equivalents thereto.

The Examiner also rejected claims 19-21 under 35 U.S.C. 103(a) "as being unpatentable over Fortunak (5700939)." Specifically, the Examiner asserted that:

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Fortunak generically discloses the instant compound (columns 3-4, compound II; columns 29-30, claims 1-4). Specific examples are described (column 16, compound 16 and 17).

Compound 16 and compound 17 have cyano and carboxylate respectively whereas the instant has bromo. However, Fortunak teaches that cyano, carboxylate, bromo are all optional choices for Y (column 29, lines 65-67). Furthermore, an example of bromo as Y is shown (column 16, compound 14a), and bromo as Y is specifically claimed in claim 4.

At the time of the invention, one of ordinary skill in the art would be motivated to modify Fortunak's example compound 16 or 17 by replacing the cyano or carboxylate with the alternative, exemplified bromo to arrive at the instant invention with the reasonable expectation of obtaining an additional intermediate compound in the preparation of camptothecin since Fortunak had clearly taught that any of the species within the disclosed genus would be effective in the camptothecin synthesis.

Applicants have canceled claims 19-21, thereby obviating the Examiner's rejection.

The Examiner indicated that claim 23 is allowed. Specifically the Examiner indicated that:

Yoshida (6531602) is not prior art. Yoshida generically discloses a 2-pyridinylsilane compound, which does not have the instant R10. Motivation to modify Yoshida's compound to arrive at the compound of instant claim 22 is lacking.

Fortunak's compound of formula I (column 1) does not have the silyl substituent on the pyranopyridine as in the compound of instant claim 23. Motivation to modify Fortunak's compound to arrive at the compound of instant claim 23 is lacking.

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In view of the above amendments and remarks, the Applicants respectfully requests that the Examiner, indicate the allowability of the Claims, and arrange for an official Notice of Allowance to be issued in due course.

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